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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,930	04/30/2001	Clifford Alan Pickover	YOR920000836US1	3343
24299	7590	02/25/2005	EXAMINER	
George Sai-Halasz 145 Fernwood Dr. Greenwich, RI 02818			YIMAM, HARUN M	
			ART UNIT	PAPER NUMBER
			2611	
DATE MAILED: 02/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,930

Applicant(s)

PICKOVER ET AL.

Examiner

Harun M. Yimam

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>04/02/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The limitation of claim 6, "wherein the broadcast channel is a radio station" should be provided in the specification. The appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 3, 4, 5, 7, 8, 14, 15, 16, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 31, 32, 33, and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Hamilton (US 2002/0087973).

Considering claims 1 and 2, Hamilton discloses a method for presenting information to a client, wherein the information is an advertisement (paragraph 0016, lines 1-3 and paragraph 0039, lines 1-4). An action by the client is detected, wherein the action—changing a channel (paragraph 0014, lines 1-6) is causing a break in the media content and the information is inserted into the break of the media content (paragraph 0013, lines 1-5 and paragraph 0036, lines 1-4).

Regarding claim 3, Hamilton discloses an advertisement, which is an announcement—the act of making a broadcast message, especially a commercial, known publicly.

As for claims 4, 5, and 7, Hamilton discloses that the action by the client comprises the step of changing a cable television broadcast channel (paragraph 0037, lines 8-10 and paragraph 0040, lines 21-26).

With regards to claim 8, Hamilton discloses that the action by the client comprises the step of loading a web page (paragraph 0043, lines 14-24).

Considering claims 14 and 15, the choice of the advertisement is facilitated by an intelligent agent—Signal Insertion Module (560 in figure 5, paragraph 0033, lines 8-10

and paragraph 0036, lines 1-4), wherein the intelligent agent accepts an input from the client (paragraph 0018, lines 1-4).

As for claim 16, Hamilton discloses that the advertisements are ordered and prioritized for display depending on the characteristics of the media contents bracketing the action by the client—which channel is being tuned to or tuned from (paragraph 0019, lines 4-7).

Regarding claims 19 and 20, Hamilton discloses a method for storing one or more advertisements (paragraph 0033, lines 8-10 and 556 in figure 5) wherein the choice of the advertisements is determined by a queuing sequence (paragraph 0019, lines 1-7).

As for claims 21, Hamilton discloses a method for refreshing the one or more advertisements—a method for loading updated advertisements (paragraph 0037, lines 5-8 and paragraph 0016, lines 1-2).

Considering claims 22 and 23, Hamilton discloses that the step of refreshing the one or more advertisements transpires over a broadcast network (paragraph 0037, lines 8-12) wherein the network is the Internet (paragraph 0015, lines 4-5).

With regards to claim 24, Hamilton discloses a computer data signal encoding a computer program of instructions for executing a computer process for presenting the said information to a client (see figure 4, paragraph 0032, and paragraph 0015, lines 6-12).

Regarding claim 25, Hamilton discloses a system for presenting information comprising a first device for detecting a break in the media content—local watchdog module or processor (paragraph 0014, lines 2-6 and paragraph 0040, lines 3-5) and a second device for inserting the information into the break of the media content—Signal Insertion Module (560 in figure 5, paragraph 0033, lines 8-10 and paragraph 0036, lines 1-4).

Considering claim 26, Hamilton discloses that the local watchdog module and the signal insertion module (560 in figure 5) are co-located in a single physical unit—STB or set top box (500 in figure 5 and paragraph 0033, lines 1-10).

As for claim 27, Hamilton discloses that the information presented to a client is a message—an announcement or an advertisement (paragraph 0016, lines 1-3 and paragraph 0039, lines 1-4).

Considering claim 28, Hamilton discloses an advertisement, which is an announcement—the act of making a broadcast message, especially a commercial, known publicly.

With regards to claim 29, Hamilton discloses that the media content is transmitted over a television channel (paragraph 0040, lines 21-26).

Regarding claim 31, Hamilton discloses that the second device—Signal Insertion Module (560 in figure 5, paragraph 0033, lines 8-10 and paragraph 0036, lines 1- 4) is further adapted to accept advertisements (paragraph 0038, line 3 – paragraph 0039, line 4) for insertion from a storage medium—a storage device (556 in figure 5 and paragraph 0033, lines 8-10).

As for claims 32, Hamilton discloses that the storage medium—memory (556 in figure 5) accepts a refreshment of the advertisements (paragraph 0037, lines 1-6).

Considering claims 33 and 34, Hamilton discloses that the step of refreshing the one or more advertisements transpires over a broadcast network (paragraph 0037, lines 8-12) wherein the network is the Internet (paragraph 0015, lines 4-5).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton (US 2002/0087973) and Duhault (US 5,900,868).

Considering claims 6 and 30, Hamilton discloses that the action by the client comprises the step of changing a cable television broadcast channel (paragraph 0037, lines 8-10 and paragraph 0040, lines 21-26). Hamilton fails to disclose that the broadcast channel is also a radio station and a channel as recited in the claims respectively.

In analogous art, Duhault discloses an audio signal of a broadcast radio channel and station (column 3, lines 11-16) where a user can select a preferred broadcast channel (column 2, lines 26-30).

It would have been obvious to one of ordinary skill in the art to modify Hamilton's system to include a radio station and a channel as an additional means of a broadcast

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channel, as taught by Duhault, for the benefit of being able to broadcast signals over a radio network.

6. Claims 9, 10, 11, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton in view of Ginter (US 5,892,900).

Considering claims 9, 10, 11, 12, and 13, Hamilton discloses a method for presenting information to a client where an action by the client is detected and the information is inserted into the break of the media content. Hamilton fails to disclose that the action by the client comprises the step of specifically controlling a media player, wherein the media player is a compact disk player, an audio tape player, a video player, or a multimedia player.

In analogous art, Ginter discloses an electronic appliance (600) that can be controlled by a user through channel selectors or a remote control device for use with broadcast and/or cable transmissions (column 62, lines 32-42). Ginter further discloses that this system (600) better supports advertising and usage information gathering (column, lines 2-3) and may include a media player including compact disk players, audio tape players, video players, and multimedia players (column 62, lines 42-46).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Hamilton and Pontenzone to include a media player, wherein the

media player is a compact disk player, an audio tape player, a video player, or a multimedia player, as taught by Ginter, for the benefit of sending advertisements over different networks to viewers using different media players.

7. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton and further in view of Klosterman (US 2001/0013124).

Regarding claim 17, Hamilton discloses that the advertisements are ordered and prioritized for display depending on which channel is being tuned to or tuned from (paragraph 0019, lines 4-7). Hamilton fails to specifically disclose that the choice of the advertisement is determined by the characteristics of the media content immediately preceding the action by the client.

In analogous art, Klosterman discloses that the choice of the advertisement is determined by the characteristics of the media content— type of program that the viewer was watching, immediately preceding the action by the client—activating the electronic program guide, EPG (paragraph 0067, lines 3-12).

It would have been obvious to one of ordinary skill in the art to modify Hamilton's invention to specifically disclose that the choice of the advertisement is determined by the characteristics of the media content immediately preceding the action by the client, as taught by Klosterman, for the benefit of transmitting targeted advertising.

As for claim 18, Hamilton discloses that the advertisements are ordered and prioritized for display depending on which channel is being tuned to or tuned from (paragraph 0019, lines 4-7). Hamilton fails to specifically disclose that the choice of the advertisement is determined by the characteristics of several of the media contents preceding the action by the client.

In analogous art, Klosterman discloses that the choice of the advertisement is determined by the characteristics of several of the media contents— type of program that the viewer was watching and the channel to which the viewer was tuned to preceding the action by the client—activating the electronic program guide, EPG—the channel provides several programs (paragraph 0067, lines 3-12).

It would have been obvious to one of ordinary skill in the art to modify Hamilton's invention to specifically disclose that the choice of the advertisement is determined by the characteristics of several of the media contents preceding the action by the client, as taught by Klosterman, for the benefit of transmitting targeted advertising.

8. Claims 35 - 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton (US 2002/0087973) in view of Perine (US 5,200,825).

Considering claim 35, Hamilton discloses a method for developing a capability for inserting an advertisement into a break in a media content, wherein the break being caused by a client interacts with the media content (paragraph 0013, lines 1-5, paragraph 0036, lines 1-4 and paragraph 0016, lines 1-3). Hamilton fails to disclose a method for media content suppliers for collecting revenues from one or more advertisers for having exposed the client to the advertisement.

In analogous art, Perine discloses an insertion of a commercial video signal on a per channel switch basis (column 3, lines 32 – 39) and a method for media content suppliers for billing the advertisers for actually played commercials—collecting revenue, (column 9, lines 34-38) for having exposed the client to the advertisement (column 9, lines 40-45).

It would have been obvious to one of ordinary skill in the art to modify Hamilton's system to include a method for collecting revenue from one or more advertisers for having exposed the client to the advertisement, as taught by Perine, for the benefit of billing the advertisers for those commercials viewed by the client.

As for claim 36, Hamilton and Perine a method for developing a capability for inserting an advertisement into a break in a media content. In particular, Perine discloses that the step of developing a capability further comprises the step of collaborating with a supplier—cable system operator (column 2, lines 55-60 and column

10, lines 35-39), wherein the supplier delivers the media content to the client (column 9, lines 40-45).

Regarding claim 37, Hamilton and Perine disclose that the step of developing the capability further comprises collaborating with a supplier. In particular, Perine discloses that the step of collaborating comprises monetary payment to the supplier—collecting revenue and generating appropriate bills for the cable system operator (column 9, lines 35-40 and column 10, lines 45-50).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harun M. Yimam whose telephone number is 703-305-0636. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 703-305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HMY

A handwritten signature in black ink, appearing to read "Chris Grant", with a stylized flourish at the end.

CHRIS GRANT
PRIMARY EXAMINER